

REMARKS

This application has been carefully reviewed in light of the Office Action of November 2, 2006. Claims 1, 2, 4-12 and 14-39 are presented for examination. Claims 1, 2, 4, 6, 8, 14, 16, 20-25, 30, 32, 33 and 37 have been amended to define still more clearly what Applicant regards as his invention; the changes made address the rejections, discussed below, under 35 U.S.C. § 112; nonetheless, these changes are neither intended nor believed to narrow the scope of any claim element. Claims 1, 4, 6, 8, 10, 12, 14, 16, 18-21, 34, 36 and 38 are the independent claims. Favorable reconsideration is requested.

In the outstanding Office Action, Claims 1, 2, 4-12 and 14-39 were rejected under 35 U.S.C. § 112, first paragraph, on the ground that the specification, as filed, does not provide such written description as would have shown to one of ordinary skill that Applicant at the time of filing had possession of the invention set out in those claims, particularly with regard to the “determination step of determining a display capability of the image display device”.

While Applicant does not agree with the propriety of the rejection under Section 112, the claims have nonetheless been amended by changing a “determining a display ...” to “obtaining a display ...”. Applicant notes that the term “obtaining” is in the specification as filed, e.g., at page 22, line 18, and accordingly these amendments provide language that is clearly supported by adequate written description. Accordingly, withdrawal of this rejection is respectfully requested.

In addition, Claims 1, 4-10, 12, 14 and 16-39 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent Application Publication 2001/0041056 (*Tanaka '056*) in view of Japanese Laid-Open Patent Application 06-233044 (*Tanaka*

'044), and Claims 2, 11 and 15, as being obvious from *Tanaka '056* in view of *Tanaka '044* and further in view of U.S. Patent 6,313,877 (*Anderson*). Applicant believes that this is a repetition of the previous prior-art rejection, and that this rejection has simply been repeated because no weight was given to the claim elements that the Examiner deems to lack adequate support.

Accordingly, Applicant incorporates herein all the arguments presented in his Amendment dated June 13, 2006, as if they were set forth herein full; in addition, Applicant submits the following observations.

First, Applicant notes the Examiner's belief that Applicant has mischaracterized the proposed combination of *Tanaka '056* and *Tanaka '044*, in his Amendment dated June 13, 2006. Applicant understands that the combination proposed by the Examiner is that stated at page 2 of the outstanding Office Action. Applicant's previous argument, which Applicant maintains, is that a person of merely ordinary skill would not have been led to consider that combination of *Tanaka '056* and *Tanaka '044*, and that a person of merely ordinary skill, if he or she attempted to derive anything from the two *Tanaka '056* and *Tanaka '044* documents together at all, would only have been able to obtain the result set out by Applicant in that Amendment. To start from *Tanaka '056* and *Tanaka '044* and reach the result suggested by the Examiner, in contrast, would have required a number of insights and logical jumps not suggested by anything in the prior art, but only in Applicant's own disclosure. That proposed combination, therefore, appears to Applicant to be either merely the result of hindsight, which is an impermissible basis for a rejection, or the result of the exercise of far more than ordinary skill, which also cannot support a proper obviousness rejection.

In any event, and as previously argued, one notable feature of the aspects of the present invention to which the respective independent claims are directed, is determining whether an image is to be displayed or characters related to the image are to be displayed, and that this determination is made *in accordance with the display capability of the image display device* and the number of images stored in an image storage device.

Moreover, one feature of the aspects of the present invention set out in Claims 34, 36 and 38 is transmitting data of a kind corresponding to *display* the capability of the image reception device and the number of images to the image reception device.

In the Office Action, the Examiner states that *Tanaka '044* “teaches a method for receiving images with an image reception device (a fax machine) that employs a determination step as to whether to output the images or a report about the images depending on whether the number of received images is greater than a threshold value ([0028]).” Office Action, paragraph bridging pages 4 and 5. Applicant notes, however, that the Office Action does not mention display capability. Indeed, nothing has been found in either *Tanaka '056* or *Tanaka '044* that would teach or suggest considering both (a) display capability of the image display device and (b) the number of images stored in the image storage device.

Accordingly, the independent claims herein are believed to be clearly allowable over those two documents, taken separately or in any permissible combination, if any.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as

references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and allowance of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

/Leonard P Diana/
Leonard P. Diana
Attorney for Applicant
Registration No. 29,296

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200